

**U.S. District Court
Northern District of Ohio (Cleveland)
CIVIL DOCKET FOR CASE #: 1:07-cv-00278-LW
Internal Use Only**

UCAR Carbon Company, Inc. v. Touchstone Research
Laboratory, Ltd.
Assigned to: Judge Lesley Wells
Cause: 35:145 Patent Infringement

Date Filed: 01/31/2007
Date Terminated: 01/07/2009
Jury Demand: Plaintiff
Nature of Suit: 830 Patent
Jurisdiction: Federal Question

Plaintiff

UCAR Carbon Company, Inc.

Pat. # 6,849,098 B1

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		2/21/08)(C,LS) (Entered: 02/21/2008)
02/21/2008	<u>43</u>	Response to Plaintiff UCAR Carbon Company's Supplemental Brief in Opposition to Defendant's Motion (1) to Dismiss Count I (Non-Infringement and Invalidity) for Lack of Jurisdiction, and (2) to Dismiss and for Summary Judgment on Counts II and III (Equitable and Legal Estoppel) filed by Touchstone Research Laboratory, Ltd.. Related document(s) <u>41</u> . (Zych, Thomas) (Entered: 02/21/2008)
01/06/2009	<u>44</u>	Memorandum Opinion and Order Granting Defendant's Motion to Dismiss Counts I & III, Denying Summary Dismissal of Count II, and Granting Defendant's Motion to Transfer. This transfer moots UCAR's pending motion for oral argument. (Doc. 37) Accordingly this case is transferred to the Northern District of West Virginia for further Proceedings on Count II of the Complaint re <u>35</u> Motion for oral argument filed by Touchstone Research Laboratory, Ltd., <u>14</u> Motion to dismiss <i>Defendant's Motion (1) To Dismiss Count I (Non-Infringement and Invalidity) for Lack of Jurisdiction, and(2)to Dismiss and for Summary Judgment on Counts II and III (Equitable and Legal Estoppel) filed by Touchstone Research Laboratory, Ltd. Judge Lesley Wells on 1/6/09. (E,P) (Entered: 01/06/2009)</i>
01/07/2009		FILING ERROR: DISREGARD:(E,P) Modified on 1/7/2009 (E,P). (Entered: 01/07/2009)
01/07/2009		Case transferred electronically to District of West Virginia Northern. (C,KA) (Entered: 01/07/2009)
01/07/2009		(Court only) FILING ERROR: DISREGARD. (B,B) Modified text on 1/7/2009 (B,B). (Entered: 01/07/2009)
01/09/2009		Case transferred from Ohio Northern has been opened in Northern District of West Virginia [Live] as case 5:09-cv-00002, filed 01/08/2009. (S,He) (Entered: 01/09/2009)

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

UCAR CARBON COMPANY, INC.)	CASE NO.
12900 Snow Road)	
Parma, Ohio 44130,)	
)	COMPLAINT FOR DECLARATORY
Plaintiff,)	JUDGMENT OF PATENT INVALIDITY
)	AND NON-INFRINGEMENT, OR IN THE
v.)	ALTERNATIVE, FOR DECLARATORY
)	JUDGMENT ENFORCING A LICENSE
TOUCHSTONE RESEARCH)	BETWEEN THE PARTIES
LABORATORY, LTD.)	
The Millennium Centre)	DEMAND FOR JURY TRIAL
Triadelphia, WV 26059,)	
)	
Defendant.)	
)	

Plaintiff UCAR Carbon Company, Inc. ("Plaintiff" or "UCAR"), by and through its undersigned counsel, hereby files this Complaint against Defendant Touchstone Research Laboratory, Ltd. ("Touchstone") and avers as follows:

NATURE OF THE ACTION

1. This is an action based on the Patent Laws of the United States, 35 U.S.C. § 1 *et seq.*, seeking a declaratory judgment of invalidity and non-infringement of United States Letters Patent No. 6,849,098 B1 for "COMPOSITE TOOLING" ("the '098 patent"). A true and correct copy of the '098 patent is attached as Exhibit A.

2. In the alternative, Plaintiff also seeks a declaratory judgment enforcing a license between the parties, as further defined and described below.

THE PARTIES

3. Plaintiff UCAR is a corporation organized and operating under the laws of the State of Delaware, having a principal place of business at 12900 Snow Road, Parma, Ohio 44130.

4. UCAR is a subsidiary of GrafTech International, Ltd., a holding company organized and operating under the laws of the State of Delaware, having a principal place of business at 12900 Snow Road, Parma, Ohio 44130. Many of UCAR's products are sold in connection with the GrafTech name.

5. Upon information and belief, Defendant Touchstone is a corporation organized and existing under the laws of the State of West Virginia, having a principal place of business at The Millennium Centre, Triadelphia, West Virginia 26059.

6. Upon information and belief, Touchstone has regularly conducted business in Ohio, including distributing its products, providing consulting services, and negotiating the license agreement in issue in this case in Ohio.

7. Upon information and belief, Touchstone derives substantial revenue from the distribution of its products and the providing of services in Ohio and in this judicial district.

JURISDICTION AND VENUE

8. This Court has subject matter jurisdiction over this controversy concerning declaratory judgment that the claims of the '098 patent are invalid and not infringed by virtue of 28 U.S.C. §§ 1331, 1338(a), 2201 and 2202.

9. Because there exists a diversity of citizenship among the parties and the amount in controversy, exclusive of interest and costs, exceeds \$75,000, this Court also has jurisdiction over the subject of this action pursuant to 28 U.S.C. § 1332.

10. This Court has personal jurisdiction over Touchstone pursuant to the provisions of the Ohio Long Arm Statute, 28 O.R.C. § 2307.382, and the laws of the United States.

11. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391.

FACTUAL ALLEGATIONS

The Market for Carbonaceous Foam Tools

12. UCAR is an industry leader in the research and development of carbon products. Since the 1960s, UCAR (or its predecessor company) has been engaged in the manufacture and sale of carbonaceous foam.

13. Carbonaceous foam may be used in a variety of applications. Historically, it has been used in creating thermal protection systems, such as insulating walls in industrial applications and nosecones in aerospace and defense applications.

14. Beginning in or around 2003, members of the aerospace industry began to demand that large mechanical parts, such as airplane fuselages and wings, be manufactured of carbon composite materials, rather than of metallic materials, as was the historical practice. To form such large carbon composite pieces, a tool, or substrate, is needed as a mold upon which to apply the carbon composite that becomes the airplane part. Given the large dimensions of the parts to be manufactured, it is important that the tool is strong, but not too heavy. It is also important that the tool has a uniform coefficient of thermal expansion so that the resulting carbon composite part is not warped or distorted. Carbonaceous foam is known to have such desirable characteristics.

15. Upon information and belief, defendant Touchstone is a maker of carbonaceous foam and carbonaceous foam tools.

16. Upon information and belief, in or around 2003, The Boeing Company or an affiliate thereof (hereinafter "Boeing") contacted Touchstone to determine whether Touchstone could manufacture carbonaceous foam that would be suitable for creating large carbonaceous foam tools.

17. Upon information and belief, Touchstone failed to deliver carbonaceous foam of quality or quantity suitable for Boeing's purposes.

18. On or around early 2004, Boeing contacted UCAR to determine whether UCAR could manufacture carbonaceous foam that would be suitable for creating large carbonaceous foam tools. After a series of successful pilot tests, UCAR determined that it was capable of manufacturing carbonaceous foam to suit Boeing's purposes, and in October, 2004, Boeing placed an order with UCAR for carbonaceous foam to be used in large tooling applications.

19. Upon information and belief, Boeing was satisfied with the carbonaceous foam it purchased from UCAR.

20. Subsequently, the demand for carbonaceous foam for use in tooling applications has increased.

21. Upon information and belief, a significant unmet market demand for carbonaceous foam for use in tooling applications presently exists.

22. In addition, recent technological breakthroughs by scientists at UCAR have allowed carbonaceous foam to be manufactured in larger pieces than ever before possible. This is particularly advantageous for large tooling applications, because fewer pieces need to be joined together to make the tool, thus reducing the number of seams in the tool and the resulting carbon composite part.

The License Agreement

23. Upon information and belief, the '098 patent issued on February 1, 2005.

24. Upon information and belief and according to the records of the U.S. Patent and Trademark Office, Touchstone is the assignee and sole owner of the '098 patent. A true and correct copy of the assignment recordation is attached as Exhibit B.

25. The '098 patent is directed to carbonaceous foam tools, wherein the carbonaceous foam has certain specified physical properties that the patent describes as advantageous.

26. After learning of the issuance of the '098 patent, UCAR began exploring the possibility of entering into a business relationship with Touchstone.

27. Initially, UCAR considered acquiring all or part of Touchstone, but a suitable agreement could not be reached.

28. By early 2006, UCAR and Touchstone had agreed to enter into a license agreement, the basic terms of which were set forth in a term sheet. Pursuant to the term sheet, Touchstone agreed to grant UCAR an exclusive (except as to Touchstone) worldwide license to certain Patent Rights, which are listed in Exhibit C hereto and include the '098 patent. In exchange for a license to the Patent Rights, UCAR agreed to pay royalties to Touchstone based on UCAR's sales of carbonaceous foam for use in tooling applications.

29. Over the course of the next several months, UCAR and Touchstone negotiated through the exchange of multiple drafts of the license agreement, meetings in Ohio, telephone conferences, email and written correspondence.

30. The principal point to be negotiated was the royalty rate to be paid by UCAR for the license. UCAR was initially unwilling to pay the royalty rate demanded by Touchstone for various reasons, including the fact that UCAR had questions regarding the non-infringement and invalidity of the '098 patent. Touchstone led UCAR to believe that it would grant UCAR the license to the Patent Rights, if UCAR agreed to pay a royalty rate of a certain percentage. By mid-June 2006, UCAR had agreed to pay the royalty rate demanded by Touchstone.

31. After exchanging further drafts of the license agreement, on September 26, 2006, counsel for Touchstone sent counsel for UCAR a memorandum summarizing Touchstone's remaining comments.

32. On September 28, 2006, UCAR's counsel wrote back to Touchstone's counsel, responding to each of his comments and conceding to nearly every one of Touchstone's remaining demands. A revised draft of the license agreement containing UCAR's concessions was enclosed (hereinafter the "September 28, 2006 License Agreement").

33. UCAR expected to receive Touchstone's signature on the September 28, 2006 License Agreement. Instead, UCAR received no response.

34. UCAR tried unsuccessfully on several occasions to contact Touchstone to receive an update on Touchstone's review of the September 28, 2006 License Agreement. After more than two months of unexplained silence from Touchstone, UCAR's counsel sent a letter to Touchstone's counsel dated December 8, 2006 in an effort to reestablish communications.

35. Touchstone's counsel responded with a letter dated December 13, 2006, which conveyed Touchstone's decision to declare formally that it was putting further negotiations with UCAR on hold (hereinafter the "December 13 Letter"). The December 13 Letter further stated that Touchstone was in the process of reevaluating its strategic business strategy, and planned to complete its strategic reevaluation by the end of February 2007.

Touchstone's Knowledge and Encouragement of UCAR's Marketing Efforts

36. Throughout the 2005-2006 timeframe, and including the timeframe during which UCAR and Touchstone were negotiating regarding the license agreement, UCAR was actively marketing its carbonaceous foam for use in tooling applications. For example, UCAR devoted significant efforts toward contacting potential customers in the market, UCAR attended several

tradeshows where it displayed its carbonaceous foam in tooling applications, and UCAR scientists presented their product research at industry conferences. Upon information and belief, Touchstone was aware of the foregoing efforts by UCAR, and did not object.

37. To the contrary, Touchstone in fact encouraged UCAR to increase its efforts. For example, in the course of the negotiation of the license agreement, Touchstone expressed concern that UCAR was not doing enough to build the market for carbonaceous foam for use in tooling applications, thus limiting the amount of royalties Touchstone would receive under the agreement. Thereafter, UCAR devoted additional resources toward developing the market for carbonaceous foam for use in tooling applications.

38. In July, 2006, Touchstone's counsel noted in an email to UCAR's counsel that the media was reporting that UCAR was making and selling carbonaceous foam for tooling applications. Touchstone's counsel requested a representation from UCAR regarding the amount of carbonaceous foam it had sold to date for these applications.

39. In response, UCAR provided information to Touchstone regarding its current and planned activities in the carbonaceous foam tooling market. Thereafter, Touchstone continued to lead UCAR to believe that it would be granted a license to the Patent Rights.

40. Due largely to the research and marketing efforts of UCAR, which were made in reasonable reliance on its belief that it would be granted a license to the Patent Rights, the demand for carbonaceous foam for use in tooling applications has increased, building a market for carbonaceous foam that did not exist prior to UCAR's efforts.

41. In October, 2006, representatives from both Touchstone and UCAR attended the "R&D 100 Awards" convention and ceremony. UCAR had a booth at the convention, which prominently and publicly displayed UCAR's carbonaceous foam for use in tooling applications.

42. Upon information and belief, Brian Joseph, a principal of Touchstone and one of the named-inventors on the '098 patent, photographed UCAR's booth at the 2006 R&D 100 Awards, including the carbonaceous foam tool display.

43. Before receiving the December 13 Letter, UCAR made a significant commitment to supply carbonaceous foam for use in tooling applications to a distributor.

44. Upon information and belief, Touchstone is capable of using publicly available specifications for UCAR's carbonaceous foam, or analyzing a sample of UCAR's carbonaceous foam, to determine whether it has the physical properties identified in the '098 patent.

45. Upon information and belief, Touchstone's strategic business strategy is to capitalize on the market UCAR created for carbonaceous foam for use in tooling applications, while using the '098 patent to exclude UCAR from that market.

46. Upon information and belief, Touchstone plans to implement the foregoing strategic business strategy before the end of February 2007, the deadline provided in the December 13 Letter.

47. In view of the totality of the circumstances, including the facts set forth above, Plaintiff reasonably apprehends that a suit will imminently be filed against it in this district or elsewhere under 35 U.S.C. Section 271 alleging inducement of infringement of the '098 patent by Plaintiff's continued making, offering to sell, selling, or distributing carbonaceous foam for use in tooling applications.

48. In view of the totality of the circumstances, including the facts set forth above, there is a substantial and continuing justiciable controversy between Plaintiff and Touchstone as to the validity and non-infringement of the claims of the '098 patent.

49. In view of the totality of the circumstances, including the facts set forth above, there is a substantial and continuing justiciable controversy between Plaintiff and Touchstone as to whether UCAR has been granted a license to the Patent Rights.

50. In the absence of an adjudication of the claims set forth herein, Plaintiff will suffer substantial hardship. By misleading UCAR into believing that it would be granted a license to the Patent Rights, Touchstone has unfairly put UCAR at greater risk for patent infringement damages, the magnitude of which is presently accruing. Touchstone has jeopardized UCAR's marketing and development efforts, which were continued in reliance upon its reasonable belief that it had a license agreement with Touchstone.

51. If the claims set forth herein are adjudicated, Plaintiff may continue its efforts to satisfy the present unmet market demand for carbonaceous foam in tooling applications.

**COUNT I:
DECLARATORY JUDGMENT OF PATENT INVALIDITY
AND NON-INFRINGEMENT**

52. Plaintiff incorporates herein by reference all of the averments set forth in paragraphs 1 through 51 as if fully rewritten herein.

53. Upon information and belief, the claims of the '098 patent are invalid for failure to comply with the requirements of Title 35 of the United States Code, including but not limited to 35 U.S.C. §§ 102, 103, or 112.

54. Upon information and belief, Plaintiff has not directly infringed or induced the infringement of any valid claims of the '098 patent.

55. Upon information and belief, no valid claims of the '098 patent are being directly infringed by any third party purchaser of Plaintiff's carbonaceous foam.

V.

Defendant

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Ltd.**

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COUNT II:
DECLARATORY JUDGMENT OF EQUITABLE ESTOPPEL

56. Plaintiff incorporates herein by reference all of the averments set forth in paragraphs 1 through 55 as if fully rewritten herein.

57. Through misleading conduct, Touchstone led UCAR to reasonably believe that it would be granted a license to the Patent Rights.

58. In reasonable reliance on its belief that it would be granted a license to the Patent Rights, UCAR has invested significant marketing efforts and research and development resources toward the manufacture and sale of carbonaceous foam for use in tooling applications, thereby building a market for carbonaceous foam that did not exist prior to UCAR's efforts.

59. Due to its reliance on Touchstone's misleading conduct, UCAR will be materially prejudiced if it is not granted a license to the Patent Rights. Moreover, Touchstone will be unjustly enriched if it is permitted to capitalize on the market for carbonaceous foam for use in tooling applications to the exclusion of UCAR.

60. As a result of the foregoing, Touchstone is estopped from refusing to grant UCAR a license to the Patent Rights.

61. As a result of the foregoing conduct, UCAR has been granted a license to the Patent Rights.

COUNT III:
DECLARATORY JUDGMENT OF LEGAL ESTOPPEL

62. Plaintiff incorporates herein by reference all of the averments set forth in paragraphs 1 through 61 as if fully rewritten herein.

63. Based on the conduct of Touchstone, UCAR reasonably believed that Touchstone consented to UCAR's license of the Patent Rights.

64. In exchange for its consent to UCAR's use of the Patent Rights, Touchstone received valuable consideration, including but not limited to, UCAR's promise to pay royalties based on sales of carbonaceous foam, and UCAR's building of the market for carbonaceous foam for use in tooling applications.

65. In view of the foregoing, UCAR has been granted a license to the Patent Rights.

66. By virtue of the December 13, 2006 letter and Touchstone's break-off of discussions with UCAR, Touchstone has deviated from the license to the Patent Rights granted to UCAR.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff prays:

- (a) for a judgment that the claims of the '098 Patent are invalid;
- (b) for a judgment that the claims of the '098 are not infringed;
- (c) for a judgment enjoining Defendant from asserting the '098 patent against Plaintiff, its representatives, agents, customers, and contractors, present and prospective;
- (d) for a judgment that this case is exceptional under 35 U.S.C. § 285 and an award of UCAR's costs, expenses and reasonable attorney's fees; and
- (e) for such other and further relief as may be just and appropriate;

OR, in the alternative, Plaintiff prays:

- (f) for a judgment specifically enforcing the terms of the September 28, 2006 License Agreement;
- (g) for a judgment granting Plaintiff an exclusive (except as to Touchstone) license to the Patent Rights;
- (h) for a judgment enjoining Defendant from asserting the Patent Rights

against Plaintiff, its representatives, agents, customers, and contractors, present and prospective, other than on the terms set forth in the September 28, 2006 Agreement; and

- (i) for such other and further relief as may be just and appropriate.

PLAINTIFFS' DEMAND FOR JURY TRIAL

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Plaintiff requests a jury trial on all issues so triable.

Respectfully submitted,

Dated: January 31, 2007

By: /s/ John T. Wiedemann

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Attorneys for Plaintiff UCAR CARBON
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IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

UCAR CARBON COMPANY, INC.,

Plaintiff,

-vs-

TOUCHSTONE RESEARCH
LABORATORY, LTD.,

Defendant.

: CASE NO. 1:07 CV 00278

:
: MEMORANDUM OF OPINION AND
: ORDER GRANTING DEFENDANT'S
: MOTION TO DISMISS COUNTS I & III,
: DENYING SUMMARY DISMISSAL OF
: COUNT II, AND GRANTING
: DEFENDANT'S MOTION TO
: TRANSFER

UNITED STATES DISTRICT JUDGE LESLEY WELLS

In this patent and licensing action, plaintiff UCAR Carbon Company, Inc. ("UCAR") seeks a declaratory judgment on the validity and infringement of U.S. Patent No. 6,849,098 ("098 Patent") assigned to Touchstone Research Laboratory, Ltd. ("Touchstone") that UCAR's activities do not infringe claims of the '098 Patent and that the '098 Patent is invalid. (Complaint Doc 1, Count I, hereinafter "Complaint"). UCAR also levels claims of equitable and legal estoppel on the license to the '098 Patent, seeking a declaration from the Court that UCAR has the right to practice the '098 Patent. (Complaint, Counts II-III).

Now before the Court is Touchstone's motions to dismiss UCAR's complaint for lack of declaratory judgment jurisdiction (Count I), to dismiss for failure to state a claim (Counts II-III), and for summary judgment (Counts II-III). (Docs. 14, 15). Alternatively, Touchstone has motioned to transfer this case to the District Court for the Northern

District of West Virginia pursuant to 28 U.S.C. §§ 1404(a). (Doc. 16). UCAR filed briefs in opposition to which Touchstone has replied. (Doc. 26, 27, 33).

For the reasons set forth below, this Court will grant Touchstone's motion to dismiss Counts I and III, deny its motion to summarily dismiss Count II, and grant its alternative motion to transfer the remaining claim to the Northern District of West Virginia.

I. BACKGROUND

This suit involves the '098 Patent issued by the U.S. Patent and Trademark Office on 1 February 2005 and assigned to Touchstone for the development of "carbonaceous foam" used in composite tooling.¹ (Complaint, Exhibit A). As reflected in the record, the '098 Patent was invented by Brian E. Joseph and Darren K. Rogers while in the employ of Touchstone at its single facility in Triadelphia, West Virginia. (Doc. 18, Joseph Declaration ¶¶ 6, 9, hereinafter "Joseph Dec."). The co-inventor of the '098 Patent, Mr. Rogers, separated from Touchstone in 2002 and now resides in the Oak Ridge, Tennessee area. (Joseph Dec. ¶ 5).

Together, Mr. Joseph, the President of Touchstone since 1997, and Elizabeth Kraftician, own all of the stock in this closely held corporation which employs approximately fifty people in its Triadelphia facility. (Joseph Dec. ¶¶ 3, 6). Mr. Joseph

¹Touchstone develops and manufactures CFOAM, a coal-based carbon-foam used in composite tooling, which involves machining carbon foam blocks into desired shapes to then be used as a mold for the manufacture of a range of parts. Touchstone filed an application for what was to become the '098 Patent on 9 August 2001. (Joseph Dec. ¶¶ 7, 10).

notes that Touchstone's customer base ranges from aluminum and chemical companies, to NASA, and the U.S. Department of Defense. According to the record affidavits, Touchstone relies upon federal contracting for roughly 80% of its business. (Joseph Dec. ¶ 4).

In 2005, Craig Schuler ("Mr. Schuler"), President of GrafTech International, Ltd. ("GrafTech"), which wholly owns UCAR, unilaterally approached Touchstone to explore the possibility of either acquiring or pursuing a joint venture with Touchstone as it related to "carbonaceous foam" and the acquisition of the '098 Patent. GrafTech is also a producer of carbon foam. GrafTech holds itself out as one of the leading manufacturers of carbon and graphite products for industrial applications. GrafTech manufactures its products on four continents which it sells in over 70 countries around the globe.

Mr. Schuler visited Touchstone in West Virginia and, subsequently, Touchstone representatives met with GrafTech and UCAR representatives in Cleveland, Ohio. Touchstone rejected the unsolicited approach by Mr. Schuler involving acquisition of the '098 Patent. (Doc. 19, Gregg Rosen Declaration, ¶ 2, hereinafter "Rosen Dec.").

UCAR then sought to obtain a license from Touchstone for use of the '098 Patent. According to the record evidence, the parties spent the bulk of 2006 in unsuccessful negotiations over a license for the '098 Patent. (Rosen Dec. ¶¶ 4-22). The parties traded Term Sheets for a proposed license of the '098 Patent via email, with UCAR submitting Term Sheets twice in February and again in June, and Touchstone submitting a Term Sheet to UCAR in March. After Touchstone's March Term Sheet submission, UCAR counsel James Cartiglia suggested an in-person meeting in

Cleveland, Ohio, while Touchstone's counsel suggested a meeting in Triadelphia, West Virginia. Counsel and parties compromised by meeting at the Hampton Inn located in Canfield, Ohio, midway between Cleveland and Triadelphia. In the course of the meeting, Touchstone expressly related to UCAR the four reasons for its decision not to license the '098 Patent. (Rosen Dec. ¶ 12).

According to the record, on 10 May 2006, UCAR counsel provided a summary of UCAR's marketing plan and requested a resumption of licensing discussions over the '98 Patent. In its marketing plan summary, UCAR represented that it "has 12 employees 100% devoted to the technical and commercial development of carbon foam in the tooling area (not including manufacturing personnel). The areas of focus are R&D, marketing, sales, and business management." In addition, the summary marketing plan submitted by UCAR noted they were "collaborating with a global company that currently markets products and services for the composite tooling industry. This company is an expert at providing technical and commercial solutions in composite tooling. They will collaborate with us on selling GRAFOAM for tooling as well as develop new tooling solutions." (Rosen Dec., Ex. E).

Subsequent to the March meeting in Canfield, Ohio, UCAR's counsel continued to forward proposed license agreements to Touchstone. In September 2006, Touchstone's attorney, Mr. Rosen, emailed a memorandum detailing the parties' differences. (Rosen Dec., Ex. H). UCAR responded with a "revised draft" license agreement. (Rosen Dec., Ex. I). In addition, at the time UCAR counsel Mr. Cartiglia revised the draft license agreement in August, he also stated, in the accompanying email, that UCAR should not be responsible for any royalties retroactively because

"UCAR has to date not made any sales of carbon foam for composite tooling and, as such, should not be liable for any royalties or other payments under the agreement." (Rosen Dec., Ex. G). The record indicates that this 14 August 2006 email from Mr. Cartiglia was consonant with his 25 July 2006 email to Mr. Rosen. In that email, Mr. Cartiglia responded to Mr Rosen's question of whether GrafTech or UCAR had already sold carbon foam for composite tooling, by noting succinctly that "UCAR has not made any sales of carbon foam for composite tooling to date." (Rosen Dec., Exs. N, O).

On 8 December 2006, UCAR's counsel Mr. Cartiglia sent Touchstone both a draft license agreement and a letter. In the letter Mr. Cartiglia notes:

Given the fact that all open issues expressed by Touchstone have been addressed, and that neither you nor Touchstone has responded to messages for over two months, we can only conclude that Touchstone has not been negotiating in good faith, and has been simply trying to interfere with UCAR's competitive activities. As such, unless Touchstone executes the most recent draft license agreement by December 18, UCAR withdraws its offer to license the Touchstone composite tooling intellectual property. . . .

In addition, as Touchstone is undoubtedly aware, the independent claim of the '098 patent is invalid, and is not infringed by anything UCAR is doing, and UCAR will continue to act accordingly.

(Rosen Dec., Ex. J). In his letter response of 13 December 2006 Touchstone attorney Mr. Rosen noted that UCAR had not heard from the defendants since the end of September because the company was "re-evaluating its business strategy." Mr. Rosen further responded:

As far as your conclusion that Touchstone has not been negotiating in good faith and simply has been trying to interfere with UCAR's competitive activities, nothing could be further from the truth and Touchstone categorically denies the assertion. Touchstone has precious little knowledge of UCAR's competitive activities. Indeed, UCAR made a point of sharing nothing about its business activities, plans or strategies in

relation to the use of carbon foam for composite tooling with Touchstone. The information vacuum surrounding UCAR's competitive activities created by GrafTech and/or UCAR is an important basis for Touchstone's decision to put further negotiations with GrafTech on hold.

Insofar as your assertion that "the independent claim of the '098 patent is invalid, and is not infringed by anything UCAR is doing", Touchstone disagrees that any of the claims in the patent referred to above are invalid. Furthermore, and as explained above, Touchstone has no information, other than what is available on GrafTech's website and that which it displays at trade shows, about what, if anything, UCAR is doing in relation to the use of carbon foam for composite tooling. While I can understand GrafTech's disappointment stemming from Touchstone's decision not to consummate a license agreement at this time, Touchstone is disappointed by GrafTech's veiled threats which you have made on its behalf in your December 8, 2006 letter.

(Rosen Dec., Ex. K).

Following this exchange, according to the record, Touchstone's attorney Mr. Rosen next heard from UCAR by letter on 31 January 2007, announcing UCAR's filing of a complaint with the United States Federal District Court, Northern District of Ohio asking for a declaratory judgment that Touchstone's '098 patent was invalid and that UCAR was not infringing the '098 patent. UCAR further asked the Court for a declaratory judgment enforcing a license between UCAR and Touchstone. (Rosen Dec., Ex. L, Wiedemann Letter). The Wiedemann letter did not serve the complaint on Touchstone, explaining "[i]t is UCAR's sincere desire to resolve this matter without litigation. To that end UCAR requests a meeting with Touchstone to discuss the issues identified in the Complaint. While UCAR would prefer to resolve these issues by execution of the License Agreement between the parties . . . UCAR is prepared to go forward with the litigation should that be necessary." Id.

UCAR specifically noted it would withhold serving the complaint on Touchstone until it heard whether Touchstone would be willing to meet to discuss the '098 Patent. Touchstone counsel Mr. Rosen and UCAR counsel Mr. Wiedemann arranged a meeting between the two companies for 26 February 2007 in Pittsburgh, Pennsylvania. According to Mr. Rosen, on 23 February he received an email from Mr. Wiedemann explaining that UCAR expected to leave the scheduled Pittsburgh meeting with a "fully executed license agreement." (Rosen Dec. ¶ 24). When informed by phone that "UCAR's expectations [were] unrealistic" Mr. Wiedemann told Mr. Rosen that UCAR would not attend the 26 February 2007 meeting. *Id.*

UCAR served its complaint on Touchstone on 27 February 2007 seeking a declaratory judgment that the '098 patent is invalid and, alternatively, seeking a declaratory judgment that Touchstone was estopped from denying it had granted a license in the '098 patent to UCAR.

II. DISMISSAL

In Count I of its complaint, UCAR seeks a declaratory judgment of non-infringement and invalidity from this Court regarding the '098 Patent. UCAR seeks patent-specific rulings that it does not infringe the '098 Patent, and to find the '098 Patent invalid. Touchstone asks the Court to dismiss Count I for lack of subject matter jurisdiction, pursuant to Fed. R. Civ. P. 12(b)(1), because it is lacking an actual controversy. See 28 U.S.C. § 2201(a).²

²The Declaratory Judgment Act provides:
In a case of actual controversy within its jurisdiction ... any court of the

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Date Filed	#	Docket Text
01/31/2007	<u>1</u>	Complaint with jury demand <i>and for Declaratory Judgment of Patent Invalidity and Non-Infringement, or in the Alternative, For Declaratory Judgment Enforcing a License Between The Parties</i> against Touchstone Research Laboratory, Ltd. (Filing fee 350 receipt number 2317815.). Filed by UCAR Carbon Company, Inc.. (Attachments: # <u>1</u> Exhibit A, U.S. Patent No. 6,849,098# <u>2</u> Exhibit B, Patent Assignment# <u>3</u> Exhibit C, Patent Rights# <u>4</u> Civil Cover Sheet # <u>5</u> Summons to Touchstone Research Laboratory, Ltd.) (Wiedemann, John) (Entered: 01/31/2007)
01/31/2007		(Court only) Utility Event adding attorney Charles B. Lyon for UCAR Carbon Company, Inc., Georgia K.E. Yanchar for UCAR Carbon Company, Inc.. (C,BA) (Entered: 01/31/2007)
01/31/2007		Judge Lesley Wells assigned to case. (C,BA) (Entered: 01/31/2007)
01/31/2007		Random Assignment of Magistrate Judge pursuant to Local Rule 3.1. In the event of a referral, case will be assigned to Magistrate Judge Perelman. (C,BA) (Entered: 01/31/2007)
02/01/2007	<u>2</u>	Summons and Magistrate Consent Form issued to counsel for service upon Touchstone Research Laboratory, Ltd. (Attachments: # <u>1</u> Magistrate Consent Form) (C,BA) (Entered: 02/01/2007)
02/06/2007	<u>3</u>	Corporate Disclosure Statement filed by UCAR Carbon Company, Inc.. (Wiedemann, John) (Entered: 02/06/2007)
03/05/2007	<u>4</u>	Return of Service Executed upon Touchstone Research Laboratory, Ltd. by process server on 2/27/07 filed by UCAR Carbon Company, Inc. Related document(s) <u>1</u> . (Wiedemann, John) Modified wording of text on 3/7/2007 (C, Br). (Entered: 03/05/2007)

In the context of a declaratory judgment action, this Circuit has recognized, in Sankyo Corp. V. Nakamura Trading Corp. 129 Fed. Appx. 648, 650 (6th Cir. 2005), that the basic inquiry is whether:

the conflicting contentions of the parties ... present a real, substantial controversy between the parties having adverse legal interests, a dispute definite and concrete, not hypothetical or abstract.

Babbitt v. Farm Workers Nat'l Union, 442 U.S. 289, 297-98 (1979). This jurisdictional prerequisite is firmly rooted in the United States Constitution which provides, in pertinent part, that "[t]he judicial power shall extend to all Cases, in Law and Equity, arising under this Constitution, the Laws of the United States, and Treaties ... [and] to Controversies...." U.S. Const., Art. III, sec. 2, cl. 1. This case or controversy requirement prevents federal courts from rendering advisory opinions or considering hypothetical or abstract questions. Hall v. Beals, 396 U.S. 45, 48 (1969).

To meet the jurisdictional requirements of Article III's "case" or "controversy" requirement, "a plaintiff must, generally speaking, demonstrate that he [or she] has suffered 'injury in fact,' that is 'fairly traceable' to the actions of the defendant, and that the injury will likely be redressed by a favorable decision." Bennett v. Spear, 520 U.S. 154, 162 (1997). The Supreme Court has clearly identified what qualifies as injury in fact: "[W]e have said many times before and reiterate today: Allegations of possible

United States, upon the filing of an appropriate pleading, may declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought.

28 U.S.C. § 2201. The Declaratory Judgment Act is not an independent basis for subject matter jurisdiction. Skelly Oil Co. v. Phillips Petroleum Co., 339 U.S. 667, 671-72 (1950). Rather, it provides a remedy available only if the court has jurisdiction from some other source. Cat Tech LLC v. TubeMaster, Inc., 528 F.3d 871, 879 (Fed. Cir.2008)

future injury do not satisfy the requirements of Art. III. A threatened injury must be 'certainly impending' to constitute injury in fact." Whitmore v. Arkansas, 495 U.S. 149, 158 (1990) ; Deja Vu of Nashville, Inc. v. Metropolitan Gov't of Nashville and Davidson County, Tennessee, 274 F.3d 377, 399 (6th Cir.2001) ("Ripeness requires that the 'injury in fact be certainly impending.'"); see also MedImmune, Inc. v. Genentech, Inc., 549 U.S. 118, 126-27, 127 S.Ct. 764 (2007) (concluding that declaratory judgment jurisdiction was proper in the context of a patent licensing agreement when the patentee claimed a right to royalties under the licensing agreement, and the licensee asserted that no royalties were owing because the patent was invalid and not infringed).

In overruling the Federal Circuit's "reasonable apprehension of suit" test for determining subject matter jurisdiction in declaratory judgment actions, the recent decision in MedImmune reaffirmed that the proper test for subject matter jurisdiction in declaratory judgment actions is "whether the facts alleged, under all the circumstances, show that there is a substantial controversy, between the parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment." Id. at 771. While MedImmune reiterates the proper test for subject matter jurisdiction, the facts of that case which resulted in a finding of an actual controversy, are inapplicable here. In MedImmune, the parties were already joined in a contractual relationship over the disputed patent. The declaratory judgment action addressed contract interpretation and was markedly different from the facts of the present action.

While the MedImmune standard may be analyzed directly, the Supreme Court has also developed various more specific but overlapping doctrines rooted in the same Article III inquiry, which must be met for a controversy to be justiciable, including

standing, ripeness, and a lack of mootness. See Caraco Pharmaceutical Laboratories, Ltd. v. Forest Laboratories, Inc., 527 F.3d 1278, 1291 (Fed. Cir. 2008) (citing Lujan v. Defenders of Wildlife, 504 U.S. 555, 560 (1992) (standing); Abbott Labs. v. Gardner, 387 U.S. 136, 149 (1967) (ripeness); and U.S. Parole Comm'n v. Geraghty, 445 U.S. 388 (1980) (mootness)). As satisfying these doctrines represents the absolute constitutional minimum for a justiciable controversy, they can be a helpful guide in applying the all-the-circumstances test reiterated in MedImmune.

Here, the Court finds no case or controversy where there is no definite and concrete dispute that touches the legal relations of the parties. Considering the totality of the circumstances, UCAR has not alleged a controversy of sufficient "immediacy and reality" to create a justiciable controversy. This "immediacy and reality" inquiry can be viewed through the lens of standing. To satisfy standing, the plaintiff must allege (1) an injury-in-fact, i.e., a harm that is " 'concrete' and actual or imminent, not 'conjectural' or 'hypothetical,'" (2) that is "fairly traceable" to the defendant's conduct, and (3) redressable by a favorable decision. Caraco, 527 F.3d at 1291 (quoting Steel Co. v. Citizens for a Better Env't, 523 U.S. 83, 102-03 (1998)); see also DaimlerChrysler Corp. v. Cuno, 547 U.S. 332, 342 (2006). Absent an injury-in-fact fairly traceable to the patentee, there can be no immediate and real controversy.

Taking all the facts into account, UCAR has not met this threshold burden of proving an immediate and real controversy. Important to the totality of the circumstances analysis in the instant case is that which has not occurred. Generally, the Supreme Court has affirmed declaratory judgment jurisdiction when "the parties had taken adverse positions with regard to their obligations, each side presenting a concrete

claim of a specific right" prior to the suit. SanDisk Corp. v. STMicroelectronics, Inc., 480 F.3d 1372, 1379 (Fed. Cir. 2007) (citing Aetna Life Ins. Co. of Hartford, Conn. v. Haworth, 300 U.S. 227, 240-41, 57 S.Ct. 461); see also MedImmune, 127 S.Ct. at 772-77, 127 S.Ct. 764.

In contrast, here Touchstone has not accused UCAR of infringement or asserted any rights in the '098 Patent over-against UCAR, nor have they taken any actions which imply such claims. Instead, all the Court has before it is a complaint asking, in Count I, for a declaratory judgment predicated on UCAR's allegation that its product does not infringe the '098 patent. The record reflects UCAR's consistent representation that, while it sought an exclusive license for the '098 Patent, it was not engaged in the sale of carbon foam for composite tooling. Touchstone's reasonable response to UCAR's representation was not to communicate a position on its '098 Patent with regard to any identified UCAR product or activity because UCAR represented it had no product or activity which fell within the ambit of the '098 Patent.

The record further reflects that Touchstone did not claim a specific right against UCAR and did not threaten to bring a claim against UCAR, but at most wrestled over whether entering into a licensing agreement with UCAR over the '098 Patent represented a viable economic strategy for the company, a point which Touchstone admits it was reevaluating at the time of UCAR's filed complaint. The defendant's lack of any "concrete claim of a specific right" weighs against a finding of an actual controversy, particularly given that there has been no actual injury. The lack of any evidence that Touchstone believed or planned to assert that UCAR's products infringed their patent creates a high barrier to proving that UCAR faces an imminent risk of injury.

Moreover, not only has Touchstone not taken a concrete position adverse to UCAR's, but it also has taken no affirmative actions at all related to UCAR's current product.

Because Count I of the Complaint does not present an Article III case or controversy, under the standard affirmed in MedImmune, it will be dismissed for lack of subject matter jurisdiction.

III. UCAR'S CLAIMS FOR EQUITABLE AND LEGAL ESTOPPEL

Touchstone asks the Court to dismiss, for failure to state a claim or through summary judgment, UCAR's claim for a declaratory judgment of equitable estoppel (Count II), and its claim for a declaratory judgment of legal estoppel (Count III). Under its equitable estoppel claim, UCAR maintains that Touchstone's conduct led UCAR to reasonably believe it had a license to use the '098 patent in exchange for a 5% royalty payment on a sliding scale and asks the Court to find that Touchstone may not assert otherwise. (Doc. 26, pp. 17–25). In its legal estoppel claim, UCAR further maintains that the parties had “agreed to enter into a license agreement” in early 2006 for which Touchstone received consideration at least in the form of “UCAR's promise to pay royalties based on sales of carbonaceous foam, and UCAR's building of the market for carbonaceous foam for use in tooling applications.” (Doc. 26, 25-28).

Taking up, first, the question of legal estoppel, the court in AMP, Inc. v. United States, 389 F.2d 448, 452 (Court of Claims 1968), explains:

The essence of legal estoppel that can be found in the estoppel of the implied license doctrine involves the fact that the licensor . . . has licensed . . . a definable property right for valuable consideration, and then has attempted to derogate or detract from that right. The grantor is estopped

from taking back in any extent that for which he [or she] has already received consideration.

As such, the Court looks to find, in the record, whether Touchstone licensed or assigned its right to the '098 Patent and whether it received valuable consideration in return. Reviewing the record, the Court finds no express agreement which might form the factual predicate for a claim of legal estoppel.

It is axiomatic that contract formation requires objective manifestations of intent as expressed in the contractual documents. See Bagsby v. Lewis Brothers, Inc., 820 F.2d 799, 803 (6th Cir. 1987). None of the documents involved in this matter show an express intent to contract. On their face, the draft term sheets circulated by the parties in early 2006, the period expressly referenced in UCAR's complaint (Complaint ¶28), contained a Binding Agreement Disclaimer, expressly noting:

This Memorandum of Terms has been prepared for discussion purposes only and is not intended to be a binding agreement or to evidence any binding obligations. The completion of the transaction contemplated by this Memorandum of Terms will be subject to, among other things, satisfactory negotiations and execution of definitive documents acceptable to both parties.

(Rosen Dec., Ex. A). UCAR's 29 June 2006 circulation of a "License Agreement" was expressly termed a "proposed" agreement and incorporated the parties' latest terms sheet, which included the Binding Agreement Disclaimer. (Rosen Dec., Ex. F). UCAR's 28 September 2006 circulation of a modified "License Agreement" was later referred to by UCAR, on 8 December 2006, as a "draft license agreement" which the plaintiff was prepared to withdraw unless Touchstone executed that draft license agreement by 18 December 2006. (Rosen Decl., Exs. I, J).

UCAR's reliance upon Arnold Palmer Golf Co. V. Fuqua Indus., Inc., 541 F.2d 584 (6th Cir. 1976) in support of its argument for legal estoppel indicates the importance of objective contractual documents. The "memorandum of intent" signaling a joint venture between the parties in Arnold is clearly absent in this instance, and the Court, here, finds the presence of no objective equivalent.

Accordingly, as a matter of law, the Court will dismiss UCAR's legal estoppel claim.

As to the question of equitable estoppel, the Court in A.C. Aukerman Co. v. R.L. Chaides Const. Co., 960 F.2d 1020, 1028 (Fed. Cir. 1992), laid out the three elements required to establish equitable estoppel as a bar to a patentee's suit, used in this instance by UCAR in seeking a declaratory judgment from the Court:

- a. The patentee, through misleading conduct, leads the alleged infringer to reasonably infer that the patentee does not intend to enforce its patent against the alleged infringer. "Conduct" may include specific statements, action, inaction, or silence where there was an obligation to speak.
- b. The alleged infringer relies on that conduct.
- c. Due to its reliance, the alleged infringer will be materially prejudiced if the patentee is allowed to proceed with its claim.

In this instance, UCAR's Complaint expressly alleges the necessary elements to survive Touchstone's Rule 12(b)(6) challenge. (Complaint, ¶¶ 57-59).

Further, reviewing the record and drawing all inferences in the light most favorable to UCAR, the Court finds the existence of genuine issues of fact that prevents the dismissal of UCAR's declaratory judgment equitable estoppel claim through summary judgment, at this early juncture of the proceedings. The parties' term sheets indicate an effort to reach a mutually satisfying agreement, but from the vantage of

hindsight, each party has reached different conclusions regarding intent, expectations and reliance. For example, questions arise as to whether UCAR could reasonably infer that the main purpose of the March 2006 meeting in Canfield, Ohio with Touchstone was to negotiate the royalty rate for the license agreement for the '098 Patent or whether Touchstone expressly declined UCAR's license agreement proposal. Questions also arise concerning Touchstone's 9 June 2006 encouraging email, as well as Touchstone's reception of UCAR's May 2006 submission of the "GRAFOAM Marketing Plan," which described the resources UCAR was investing in the carbon foam tooling market. Finally, UCAR disagrees with Touchstone's inference regarding UCAR's 8 December 2006 letter, that the plaintiff was withdrawing its offer, insisting instead that the letter was meant "to prompt Touchstone's execution of the finalized agreement." These differences, held in hindsight by UCAR, may ultimately have no basis in reason, but at this early juncture of the proceedings they appear as material differences requiring further inquiry.

Accordingly, the Court will deny Touchstone's request to dismiss through summary judgment UCAR's claim for a declaratory judgment of equitable estoppel.

IV. TRANSFER OF VENUE PURSUANT TO 28 U.S.C. § 1404

Touchstone alternatively moves for a transfer of venue pursuant to 28 U.S.C. § 1404(a), on the grounds that UCAR's declaratory judgment action, removed to this court, represents an improper anticipatory filing. UCAR has urged this court to retain venue in the Northern District of Ohio because its declaratory judgment action does not

constitute forum shopping. For the following reasons, the Court will grant Touchstone's motion to transfer the remaining claim in this matter.

A. Authority to Transfer Venue and Burden of Proof

In allowing for a transfer of venue, 28 U.S.C. § 1404(a) provides: "For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought." "Under 28 U.S.C. § 1404(a), a district court 'has broad discretion to grant or deny a motion to transfer [a] case.'" Phelps v. McClellan, 30 F.3d 658, 663 (6th Cir. 1994)(quoting Cote v. Wadel, 796 F.2d 981, 985 (7th Cir. 1986)).

Before deciding whether or not the "convenience of the parties and witnesses" and "the interest of justice" reasonably support a transfer, courts first determine whether the proposed alternative venues are "district[s] or division[s] where [the action might] have been brought." 28 U.S.C. § 1404(a); Stewart Organization, Inc. v. Ricoh Corp., 487 U.S. 22, 29-30 (1988).

This requires the Court to first ask (1) whether the court in the District of West Virginia could exercise original jurisdiction over the case; (2) whether that court would have personal jurisdiction of the defendants; and (3) whether venue would be proper in that court. See Jamhour v. Scottsdale Insurance Co., 211 F. Supp.2d 941, 945 (S.D. Ohio 2002).

The moving party bears the burden of proving why a court should grant a transfer. Picker Intern., Inc. v. Travelers Indem. Co., 35 F.Supp.2d 570, 573 (N.D. Ohio 1998).

B. Transfer Factors

This Court considers several factors in weighing a motion to transfer pursuant to § 1404(a), such as “the private interests of the parties, including their convenience and the convenience of potential witnesses, as well as other public-interest concerns, such as systemic integrity and fairness, which come under the rubric of ‘interests of justice.’” Moses v. Business Card Express, Inc., 929 F.2d 1131, 1137 (6th Cir. 1991); see also Stewart Org., Inc. v. Ricoh Corp., 487 U.S. 22, 30 (1988). These private interests include the plaintiff’s choice of forum, location of documents, convenience of witnesses, possibility of prejudice in either forum, and the practical problems associated with trying the case expeditiously and inexpensively. In weighing these private interest factors, the Court should consider whether the plaintiff chose an inconvenient forum to vex or harass the defendant “by inflicting upon him [or her] expense or trouble not necessary to his [or her] own right to pursue his [or her] remedy.” Gulf Oil Corp. v. Gilbert, 330 U.S. 501, 508 (1947).

Factors to be weighed in considering the public interest include docket congestion, the burden a trial would have on a jurisdiction with no connection to the litigation, and the familiarity of the court with the controlling law. Id.

Once a court analyses these factors, exercise of the court’s discretion to transfer is proper if fairness and practicality favor the forum to which transfer is sought. Mead Data Central Inc. v. West Pub. Co., 679 F. Supp. 1455, 1457 (S.D. Ohio 1987).

03/07/2007	<u>5</u>	Motion for extension of time until April 9, 2007 to answer or <i>Otherwise Respond to the Complaint</i> filed by Touchstone Research Laboratory, Ltd.. (Attachments: # <u>1</u> Pleading Declaration of Gregg M. Rosen in Support of Defendant Touchstone Research Laboratory, Ltd.'s Motion to Extend Time to answer or Otherwise Plead)(Zych, Thomas) (Entered: 03/07/2007)
03/07/2007	<u>6</u>	Attorney Appearance <i>Notice of Appearance of Counsel</i> by Thomas F. Zych filed by on behalf of Touchstone Research Laboratory, Ltd.. (Zych, Thomas) (Entered: 03/07/2007)
03/08/2007	<u>7</u>	Declaration and Exhibits <i>in Support of Defendant's Motion</i> filed by Touchstone Research Laboratory, Ltd.. Related document(s) <u>5</u> .(Zych, Thomas) Modified wording of text on 3/9/2007 (C, Br). (Entered: 03/08/2007)
03/08/2007	<u>8</u>	<i>Notice of Filing of Original Declaration in Support of Defendant's Motion to Extend Time</i> filed by Touchstone Research Laboratory, Ltd.. (Attachments: # <u>1</u> Exhibit Declaration of Gregg M. Rosen)(Zych, Thomas) Related documents <u>5</u> , <u>7</u> . Modified to create links on 3/9/2007 (C, Br). (Entered: 03/08/2007)
03/09/2007		Order [Non Document]Granting Defendant Touchstone Research Laboratory, Ltd.'s motion for an extension of time until April 9, 2007 to answer complaint. (Related Doc. #5). (Entered on behalf of Judge Lesley Wells on 3/9/2007).(C,LS) (Entered: 03/09/2007)
03/19/2007	<u>9</u>	Motion for attorney Andrew F. Pratt to Appear Pro Hac Vice Filing fee 100, receipt number 14660007290. filed by Touchstone Research Laboratory, Ltd.. Filing fee paid; receipt number 14660007290. (Zych, Thomas) (Entered: 03/19/2007)
03/19/2007	<u>10</u>	Motion for attorney Richard S. Meyer to Appear Pro Hac Vice Filing fee 100, receipt number 14660007290. filed by Touchstone Research Laboratory, Ltd.. Filing fee paid; receipt number 14660007290. (Zych, Thomas) (Entered: 03/19/2007)
03/19/2007	<u>11</u>	Motion for attorney Lynn E. Eccleston to Appear Pro Hac Vice Filing fee 100, receipt number 14660007290. filed by Touchstone Research Laboratory, Ltd.. Filing fee paid; receipt number 14660007290. (Zych, Thomas) (Entered: 03/19/2007)
03/23/2007	<u>12</u>	<i>Notice of Filing and Affidavits in Support of Motions for Admission Pro Hac Vice</i> filed by Touchstone Research Laboratory, Ltd.. (Attachments: # <u>1</u> Affidavits of Lynn E. Eccleston, Andrew F. Pratt and Richard S. Meyer) (Zych, Thomas) Modified wording of text on 3/27/2007 (C, Br). (Entered: 03/23/2007)
03/28/2007		Order [Non Document]Granting Motion for appearance pro hac vice; Attorney Andrew F. Pratt is added as counsel for Touchstone Research Laboratory, Ltd. (Related Doc # <u>9</u>)(Entered on behalf of Judge Lesley Wells on 3/28/07).(C,LS) (Entered: 03/28/2007)
03/28/2007		Order [Non Document] Granting Motion for appearance pro hac vice;

C. Balance of transfer “strongly in favor” of transfer.

In this Circuit, Gulf Oil has been cited for the proposition that a case should not be transferred unless the balance is "strongly in favor" of the party seeking the transfer. See Nicol v. Koscinski, 188 F.2d 537 (6th Cir. 1951). However, court opinions indicate the balance need not be "strongly in favor" of the party seeking the transfer, but rather need only favor the party seeking the transfer.

The “‘strong showing’ standard has its roots in cases that treated Section 1404(a) as a mere codification of the doctrine of forum non conveniens. . . .” But in 1955, the Supreme Court held that the intent of Congress in enacting section 1404(a) was not merely to codify that doctrine, but to "permit courts to grant transfers upon a lesser showing of inconvenience." Norwood v. Kirkpatrick, 349 U.S. 29, 32 (1955). That decision casts considerable doubt on the proposition that the statute requires a strong showing to overcome the plaintiff's choice of forum.

Although the Sixth Circuit has held that a request for transfer pursuant to Section 1404(a) should not be granted unless the balance of convenience is strongly in favor of the defendant, Nicol v. Koscinski, supra, Nicol is one of the pre-Norwood cases that applied the "strong showing" standard because of its applicability in cases involving forum non conveniens and is not grounded in the language of the statute or in the holding of Norwood. See Roberts Metals, Inc. v. Florida Properties Mktg. Group, Inc., 138 F.R.D. 89, 92-93 (N.D. Ohio 1991).

In Norwood, the Supreme Court adopted language set forth in a court of appeals decision which further illustrates that a "strong showing" is no longer required:

The notion that 28 U.S.C.A. § 1404(a) was a mere codification of existing law relating to forum non conveniens is erroneous. It is perfectly clear that the purpose of this section of the Revised Judicial Code was to grant broadly the power of transfer for the convenience of parties and witnesses, in the interest of justice, whether dismissal under the doctrine of forum non conveniens would have been appropriate or not.

Norwood, 349 U.S. at 31-32 (quoting Jiffy Lubricator Co., Inc. v. Stewart-Warner Corp., 177 F.2d 360, 362 (4th Cir. 1949), cert. denied, 338 U.S. 947 (1950)) (emphasis added).

The Norwood Court went on to say that "we believe that Congress, by the term 'for the convenience of the parties and witnesses, in the interest of justice,' intended to permit courts to grant transfers upon a lesser showing of inconvenience." Norwood, 349 U.S. at 32. Statements made by the dissenting Justices in Norwood indicate that they read the majority opinion as effectively eliminating the "strong showing" requirement. See Norwood, 349 U.S. at 40.

The Court therefore concludes that it is appropriate to apply a preponderance standard to the Section 1404(a) analysis. See Gdovin v. Catawba Rental Co., 596 F. Supp. 1325, 1326 & n. 1 (N.D. Ohio 1984) (applying a preponderance test on a motion to transfer). That is, the movant must show that the "forum to which he [or she] desires to transfer the litigation is the more convenient one vis-a-vis the plaintiff's initial choice." Mead Corp., 508 F.Supp. at 198. Thus, the balance need not be "strongly in favor" of the party seeking transfer; however, the moving party still bears the burden of proof that transfer would be for the convenience of both the parties and the witnesses and is in the interest of justice.

Furthermore, while a plaintiff's choice of forum is ordinarily entitled to some deference, it should carry less weight in a declaratory judgment action. "A plaintiff

brings such an action because it has perceived a threat of suit. Therefore, its posture before the court is more akin to a defendant than an ordinary plaintiff seeking relief.”

Societe Generale v. Florida Health Sciences Center, Inc., 2003 WL 22852656 at *7 (S.D.N.Y. 2003).³

In resolving this issue the Court usually engages in a two-part inquiry. Because the first part of the inquiry – whether the action “might have been brought” in the Northern District of West Virginia – is already clear, this Court turns to the second part of the inquiry – whether the proposed change of venue would facilitate the “convenience of the parties and witnesses” and serve “the interests of justice.” Rutherford v. Good Year Tire and Rubber Co., 943 F.Supp. 789, 791 (W.D. Ky. 1996), aff’d, 142 F.3d 436 (6th Cir. 1998).

An analysis of factors relevant to this case demonstrates that transfer to the Northern District of West Virginia, pursuant to Section 1404(a), is appropriate.

1. Plaintiff’s Choice of Forum

In general, a plaintiff’s choice of forum should be given “weight” when deciding whether to grant a motion to change venue though such choice is not dispositive. Lewis

³The posture toward declaratory judgment actions is consonant with the courts’ posture toward the first-to-file rule in matters of equity. Factors that weigh against enforcement of the first-to-file rule include extraordinary circumstances, inequitable conduct, bad faith, anticipatory suits, and forum shopping. See Alltrade, Inc. v. Uniworld Prods., Inc., 946 F.2d 622, 628 (9th Cir.1991). The Sixth Circuit recognizes that a district court may decline to invoke the first-to-file rule for reasons of equity. Zide Sport Shop of Ohio, Inc. v. Ed Tobergte Associates, Inc., 2001 WL 897452 at *3 (6th July 31, 2001) (district courts have discretion to dispense with first-to-file rule where equity so demands). The court has the discretion to find an exception to the first-filed rule if circumstances suggest bad faith, a merely anticipatory suit or forum shopping. Plating Res., Inc. v. UTI Corp., 47 F.Supp.2d at 903.

v. ACB Business Services, Inc., 135 F.3d 389, 413 (6th Cir. 1998). While courts have variously described the amount of weight such a choice should be afforded, see e.g. Picker, 35 F. Supp. 2d at 573 (“great weight”); U.S. v. Cinemark USA, Inc., 66 F. Supp. 2d 881 (N.D. Ohio 1999) (“substantial weight”); International Union, U.A.W. v. Aluminum Co. of America, 875 F. Supp. 430, 433 (N.D. Ohio 1991) (concluding that while “plaintiffs’ choice of forum is to be awarded some weight, it is not of paramount importance; it is instead one factor to be weighed equally with other relevant factors”), this Court finds that, under the circumstances of this case, no weight should be given to UCAR’s choice of forum but, to the contrary, considers plaintiff’s action impermissibly peremptory.

As explained in Cinemark, the “rationale for giving a plaintiff’s choice of forum ‘substantial weight’—as opposed to equal or little weight—is that, unlike defendant forum shopping, plaintiff forum shopping ‘is not an evil to be avoided, but rather is an inherent part of our federal network’” and this flexibility “encourages them to use the judicial system for their disputes.” 66 F. Supp. 2d at 889. This rationale, however, is diminished, if not wholly absent, in certain cases such as where that election resulted from a “race to the courthouse.” Veryfine Products, Inc. v. Phlo Co., 124 F. Supp. 2d 16 (D. Mass. 2000) (concluding that, in certain cases, the winner of the “race to the courthouse should not enjoy the presumption of preferable venue”); see also Alexander Ins. Ltd. v. Executive Life Ins. Co. of New York, 1991 WL 150224, *2 (S.D. N.Y., July 29, 1991).

In this case, the parties were engaged in licensing discussions, initiated by the plaintiff, regarding the ‘098 Patent. The specter of litigation arose only when

Touchstone made the business decision not to entertain licensing options for the '098 Patent under the terms offered by UCAR and Graftech. The record betrays no evidence that Touchstone considered litigation on this issue. In this context, it makes little sense to afford any weight to UCAR's and Graftech's anticipatory filing. That filing not only occurred on the heels of licensing negotiations between the parties, but the filing itself was accompanied by enticements signaling the plaintiff's intent to forego litigation if Touchstone tendered a license on its '098 Patent to UCAR, pursuant to UCAR's terms. Indeed, under these circumstances, UCAR's anticipatory filing of its declaratory action is considered prohibited procedural fencing that undermines the interests of justice.

Accordingly, this Court finds that this factor weighs against UCAR.

2. Convenience of the Parties and Witnesses

Convenience of the parties and the witnesses are important factors to weigh in the balance, as both are explicitly mentioned as considerations in Section 1404(a). Picker, 35 F. Supp. 2d at 573. With respect to convenience to the witnesses, the Court must consider the nature of each witness and the materiality of their anticipated testimony, not merely the number of prospective witnesses in each district. Royal & Sunalliance v. British Airways, 167 F. Supp. 2d 573, 577 (S.D. N.Y. 2001); 15 WRIGHT & MILLER, Federal Practice and Procedure § 3851.

In this instance, the convenience of the witnesses and parties weigh in favor of transferring venue to the Northern District of West Virginia. The record indicates that Touchstone, a closely held company of fifty employees, may well require the testimony of key management personnel, including the president, the program manager for

carbonaceous foam, and the chief financial officer, to assemble the facts regarding UCAR's remaining estoppel claim.

Further, the Court notes these key Touchstone employees must take time to address the equitable estoppel claim, which may be imposed in a patent case when a patentee is found to have wrongly induced another party to believe that it will not sue that party for operating as though it had a license agreement. See Forest Laboratories, Inc. v. Abbott Laboratories, 339 F.3d 1324 (Fed. Cir. 2003) (finding such business conduct unexceptional and concluding that defendant's "equitable estoppel" conduct was not an appropriate basis for awarding attorney fees under § 285, reversing the district court's decision). Accordingly, under the current legal landscape, Touchstone must devote a number of employee hours to address UCAR's affirmative defense of equitable estoppel. Given the constellation of events indicated in the record, the Court finds it difficult to conclude that UCAR's cause of action arose out of Touchstone's Ohio transactions. As such, in this instance, the focal point of the claim is the locus of the patent itself for which UCAR seeks to bar an argument that it does not have a license.

Moreover, the Court remains unconvinced that UCAR's ties to Ohio outweigh the convenience, and thus the case in general, of a transfer of this matter to West Virginia. The situs of the records, the manufacturing of the carbonaceous foam, and the genesis of the patent itself, over which UCAR brings its request for declaratory judgment, all center on Triadelphia, West Virginia. (Joseph Dec. ¶¶6, 9). The Court does not find that UCAR has an equivalent orientation to Ohio. While UCAR is headquartered in Ohio, the plaintiff is wholly owned by GrafTech, which together have manufacturing facilities in

several states and countries, including a manufacturing facility in Clarksburg, West Virginia.

3. Location of Documents

"While the location of evidence is generally a relevant factor in the § 1404 analysis, the location of documentary evidence is a minor consideration," given the ease with which it can be transferred between locations. Picker, 35 F. Supp. 2d at 574; see also Cinemark, 66 F. Supp. 2d at 890. Given that this case appears to principally involve documentary evidence and that these documents are interspersed between West Virginia and Ohio, this factor does not weigh in either party's favor.

4. Public and Practical Considerations

The relevant factors to be considered regarding the public's interests include: docket congestion; the burden of trial to a jurisdiction with no relation to the cause of action; the value of holding trial in a community where the public affected live; the familiarity of the court with controlling law; judicial economy and the avoidance of inconsistent judgments.

Evidence suggests the Northern District of West Virginia's civil docket may be slightly less congested than the civil docket in the Northern District of Ohio. However, given the nature of the claim and the relative posture of the parties, the Court concludes the public considerations do not heavily favor either party.

V. CONCLUSION

Touchstone's motion to dismiss UCAR's action is granted as to Counts I and III, and denied as to Count II. Further, Touchstone's motion to transfer pursuant to 28 U.S.C. 1404(a) is granted. This transfer moots UCAR's pending motion for oral argument. (Doc. 37). Accordingly, this case is hereby transferred to the Northern District of West Virginia for further proceedings on Count II of the Complaint.

IT IS SO ORDERED.

/s/Lesley Wells
UNITED STATES DISTRICT JUDGE

Date: 6 January 2009

		Attorney Richard S. Meyer is added as counsel for Touchstone Research Laboratory, Ltd. (Related Doc # <u>10</u>)(Entered on behalf of Judge Lesley Wells on 3/23/07)(C,LS) (Entered: 03/28/2007)
03/28/2007		Order [Non Document]Granting Motion for appearance pro hac vice; Attorney Lynn E. Eccleston is added as counsel for Touchstone Research Laboratory, Ltd. (Related Doc # <u>11</u>)(Entered on behalf of Judge Lesley Wells on 3/28/2007)(C,LS) (Entered: 03/28/2007)
04/09/2007	<u>13</u>	Motion for leave <i>DEFENDANT TOUCHSTONE RESEARCH LABORATORY, LTD'S UNOPPOSED MOTION FOR LEAVE TO FILE MEMORANUDM EXCEEDING PAGE LIMITATION</i> filed by Touchstone Research Laboratory, Ltd.. (Zych, Thomas) (Entered: 04/09/2007)
04/09/2007	<u>14</u>	Motion to dismiss <i>DEFENDANT'S MOTION (1) TO DISMISS COUNT I (NON-INFRINGEMENT AND INVALIDITY) FOR LACK OF JURISDICTION, AND (2) TO DISMISS AND FOR SUMMARY JUDGMENT ON COUNTS II AND III (EQUITABLE AND LEGAL ESTOPPEL)</i> filed by Touchstone Research Laboratory, Ltd.. (Zych, Thomas) (Entered: 04/09/2007)
04/09/2007	<u>15</u>	Brief <i>BRIEF IN SUPPORT OF DEFENDANT'S MOTION (1) TO DISMISS COUNT I (NON-INFRINGEMENT AND INVALIDITY) FOR LACK OF JURISDICTION, AND (2) TO DISMISS AND FOR SUMMARY JUDGMENT ON COUNTS II AND III (EQUITABLE AND LEGAL ESTOPPEL)</i> filed by Touchstone Research Laboratory, Ltd.. Related document(s) <u>14</u> . (Attachments: # <u>1</u> Exhibit A# <u>2</u> Exhibit B# <u>3</u> Exhibit C# <u>4</u> Exhibit D) (Zych, Thomas) (Entered: 04/09/2007)
04/09/2007	<u>16</u>	Motion to change/transfer venue <i>DEFENDANT'S MOTION IN THE ALTERNATIVE TO TRANSFER VENUE</i> filed by Touchstone Research Laboratory, Ltd.. (Zych, Thomas) (Entered: 04/09/2007)
04/09/2007	<u>17</u>	<i>BRIEF IN SUPPORT OF DEFENDANT'S MOTION IN THE ALTERNATIVE TO TRANSFER VENUE</i> filed by Touchstone Research Laboratory, Ltd.. Related document(s) <u>16</u> . (Attachments: # <u>1</u> Exhibit A) (Zych, Thomas) Modified text on 4/10/2007 (C, Br). (Entered: 04/09/2007)
04/09/2007	<u>18</u>	Affidavit/Declaration <i>DECLARATION OF BRIAN E. JOSEPH IN SUPPORT OF DEFENDANT TOUCHSTONE RESEARCH LABORATORY, LTD'S MOTION IN THE ALTERNATIVE TO TRANSFER VENUE</i> filed by Touchstone Research Laboratory, Ltd.. Related document(s) <u>17</u> , <u>15</u> . (Zych, Thomas) (Entered: 04/09/2007)
04/09/2007	<u>19</u>	Affidavit/Declaration <i>DECLARATION OF GREGG M. ROSEN IN SUPPORT OF DEFENDANT TOUCHSTONE RESEARCH LABORATORY, LTD'S MOTION TO MOTION (1) TO DISMISS COUNT I (NON-INFRINGEMENT AND INVALIDITY) FOR LACK OF JURISDICTION, AND (2) TO DISMISS AND FOR SUMMARY JUDGMENT ON COUNTS II AND III</i> filed by Touchstone Research Laboratory, Ltd.. Related document(s) <u>17</u> , <u>15</u> . (Zych, Thomas) (Entered: 04/09/2007)
04/09/2007	<u>20</u>	Notice <i>NOTICE OF MANUAL FILING</i> filed by Touchstone Research

		Laboratory, Ltd.. Related document(s) <u>19</u> .(Zych, Thomas) (Entered: 04/09/2007)
04/09/2007	<u>21</u>	Notice of Service <i>CERTIFICATE OF SERVICE</i> filed by Touchstone Research Laboratory, Ltd.. Related document(s) <u>17</u> , <u>14</u> , <u>19</u> , <u>18</u> , <u>16</u> , <u>15</u> . (Zych, Thomas) (Entered: 04/09/2007)
04/10/2007		Order [non-document] granting Motion by defendant Touchstone Research Laboratory, LTD., for leave to file Memorandum Exceeding Page Limitation (Related Doc # <u>13</u>). Approved by Judge Lesley Wells on 4/10/07.(G,YJ) (Entered: 04/10/2007)
04/10/2007	<u>22</u>	Exhibit A to Declaration of Gregg M. Rosen filed by Touchstone Research Laboratory, Ltd. Related document(s) <u>20</u> , <u>19</u> . (E,P)(Complete 1/2 inch thick document on file in Clerk's Office) Modified text on 4/11/2007 (E, P). (Entered: 04/11/2007)
04/20/2007	<u>23</u>	Joint Motion for extension of Time to Respond to Motion to Transfer until May 14, 2007 filed by UCAR Carbon Company, Inc.. Related document(s) <u>16</u> . (Wiedemann, John) (Entered: 04/20/2007)
04/24/2007		Order [Non Document] Granting Joint Stipulation for extension of time to respond to motion to transfer. (Related Doc. # <u>23</u>). UCAR shall have until 14 May 2007 to file a Memorandum in Opposition to Defendant's Motion to Transfer Venue and TRL shall have until 31 May 2007 to file a Reply Memorandum in support of its Motion to Transfer Venue. (Entered on behalf of Judge Lesley Wells on 4/24/07)(C,LS) (Entered: 04/24/2007)
04/26/2007	<u>24</u>	Notice of Filing of Declarations in Support of Motion to Dismiss, Motion for Summary Judgment and Motion to Transfer Venue filed by Touchstone Research Laboratory, Ltd.. (Attachments: # <u>1</u> Declaration of Gregg M. Rosen# <u>2</u> Declaration of Brian E. Joseph)(Zych, Thomas) (Entered: 04/26/2007)
05/14/2007	<u>25</u>	Unopposed Motion for leave to File Memorandum Exceeding Page Limitation filed by UCAR Carbon Company, Inc.. (Wiedemann, John) (Entered: 05/14/2007)
05/14/2007	<u>26</u>	Opposition to <u>14</u> Motion to dismiss <i>DEFENDANT'S MOTION (1) TO DISMISS COUNT I (NON-INFRINGEMENT AND INVALIDITY) FOR LACK OF JURISDICTION, AND (2) TO DISMISS AND FOR SUMMARY JUDGMENT ON COUNTS II AND III (EQUITABLE AND LEGAL ESTOPPEL)</i> Motion to dismiss <i>DEFENDANT'S MOTION (1) TO DISMISS COUNT I (NON-INFRINGEMENT AND INVALIDITY) FOR LACK OF JURISDICTION, AND (2) TO DISMISS AND FOR SUMMARY JUDGMENT ON COUNTS II AND III (EQUITABLE AND LEGAL ESTOPPEL)</i> filed by UCAR Carbon Company, Inc.. (Attachments: # <u>1</u> Exhibit A - SanDisk v. STMicroelectronics, Inc.# <u>2</u> Exhibit B - Rite-Hite v. Delta T Corp.) (Wiedemann, John) (Entered: 05/14/2007)
05/14/2007	<u>27</u>	Opposition to <u>16</u> Motion to change/transfer venue <i>DEFENDANT'S MOTION IN THE ALTERNATIVE TO TRANSFER VENUE</i> filed by UCAR Carbon Company, Inc.. (Attachments: # <u>1</u> Exhibit A - Jonsson v. The Stanley

		Works# <u>2</u> Exhibit B - Mapquest driving directions# <u>3</u> Exhibit C - Complaint, Civil Action No. 1:04 CV 327 (S.D. Ohio May 14, 2004)# <u>4</u> Exhibit D - Answer to False Claims Complaint# <u>5</u> Exhibit E - U.S. Patent No. 6,849,098# <u>6</u> Exhibit F - Federal Court Management Statistics, Table C-3B# <u>7</u> Exhibit G - Judicial Caseload Profile - Ohio Northern and W. Virginia Northern)(Wiedemann, John) (Entered: 05/14/2007)
05/14/2007	<u>28</u>	Affidavit/Declaration of <i>Diane Artman</i> in Opposition to Both Defendant's Motion to Dismiss and Defendant's Motion in the Alternative to Transfer Venue filed by UCAR Carbon Company, Inc.. (Attachments: # <u>1</u> Exhibit 1 - Certificate of Achievement# <u>2</u> Exhibit 2 - Images Displayed at UCAR's Booth# <u>3</u> Exhibit 3 - 5/10/06 email from Cartiglia to Rosen# <u>4</u> Exhibit 4 - UCAR marketing materials# <u>5</u> Exhibit 5 - UCAR presentation dated 11/1/05# <u>6</u> Exhibit 6 - UCAR presentation dated 3/28/06# <u>7</u> Exhibit 7 - "Carbon Foams and Tooling"# <u>8</u> Exhibit 8 - "Carbon Foam and Applications"# <u>9</u> Exhibit 9 - www.graftech.com website# <u>10</u> Exhibit 10 - excerpts from www.compositesworld.com)(Wiedemann, John) (Entered: 05/14/2007)
05/14/2007	<u>29</u>	Affidavit/Declaration of <i>James R. Cartiglia</i> in Opposition to Both Defendant's Motion to Dismiss and Defendant's Motion in the Alternative to Transfer Venue filed by UCAR Carbon Company, Inc.. Related document(s) <u>14</u> , <u>16</u> . (Attachments: # <u>1</u> Exhibit 1 - 2/1/06 email from Rosen to Asmussen# <u>2</u> Exhibit 2 - 2/7/06 email from Asmussen to Rosen# <u>3</u> Exhibit 3 - 2/13/06 email from Rosen to Asmussen# <u>4</u> Exhibit 4 - 2/15/06 email from Asmussen to Rosen# <u>5</u> Exhibit 5 - 2/17/06 email chain# <u>6</u> Exhibit 6 - 2/21/06 email from Rosen to Cartiglia# <u>7</u> Exhibit 7 - 2/28/06 email from Cartiglia to Rosen# <u>8</u> Exhibit 8 - 3/6/06 email from Rosen to Cartiglia# <u>9</u> Exhibit 9 - 3/10/06 email from Rosen to Cartiglia# <u>10</u> Exhibit 10 - 3/13/06 email from Rosen to Cartiglia# <u>11</u> Exhibit 11 - 5/10/06 email and GRAFOAM Marketing Plan# <u>12</u> Exhibit 12 - 5/19/06 email from Rosen to Cartiglia# <u>13</u> Exhibit 13 - 5/24/06 email from Cartiglia to Rosen# <u>14</u> Exhibit 14 - 6/9/06 email from Rosen to Cartiglia# <u>15</u> Exhibit 15 - 6/12/06 email from Cartiglia to Rosen# <u>16</u> Exhibit 16 - 6/29/06 email from Cartiglia to Rosen# <u>17</u> Exhibit 17 - 6/30/06 email from Rosen to Cartiglia# <u>18</u> Exhibit 18 - 7/19/06 email from Rosen to Cartiglia# <u>19</u> Exhibit 19 - 7/25/06 email from Cartiglia to Rosen# <u>20</u> Exhibit 20 - 8/7/06 Draft# <u>21</u> Exhibit 21 - 8/14/06 email from Cartiglia to Rosen# <u>22</u> Exhibit 22 - 9/26/06 email from Rosen to Cartiglia with Memorandum attached# <u>23</u> Exhibit 23 - 9/28/06 email and License Agreement# <u>24</u> Exhibit 24 - 12/8/06 letter from Cartiglia to Rosen# <u>25</u> Exhibit 25 - 12/13/06 letter from Rosen to Cartiglia)(Wiedemann, John) (Entered: 05/14/2007)
05/14/2007	<u>30</u>	Affidavit/Declaration of <i>John T. Wiedemann</i> in Opposition to Both Defendant's Motion to Dismiss and Defendant's Motion in the Alternative to Transfer Venue filed by UCAR Carbon Company, Inc.. Related document(s) <u>14</u> , <u>16</u> . (Attachments: # <u>1</u> Exhibit 1 - 1/31/07 letter from Wiedemann to Rosen# <u>2</u> Exhibit 2 - 2/23/07 email from Wiedemann to Rosen)(Wiedemann, John) (Entered: 05/14/2007)
05/15/2007	<u>31</u>	Exhibit(s) <u>11</u> to Declaration of <i>Diane Artman</i> in Opposition to Both

		<i>Defendant's Motion to Dismiss and Defendant's Motion in the Alternative to Transfer Venue</i> filed by UCAR Carbon Company, Inc.. Related document(s) <u>28</u> . (Attachments: # <u>1</u> Exhibit 11 - 12/13/06 letter from Rosen to Cartiglia) (Wiedemann, John) (Entered: 05/15/2007)
05/15/2007		Order [Non Document] Granting Plaintiff UCAR Carbon Company, Inc.'s Unopposed Motion for Leave to file memorandum exceeding the page limitation. (Related Doc # <u>25</u>)(Entered on behalf of Judge Lesley Wells on 5/15/07)(C,LS) (Entered: 05/15/2007)
05/31/2007	<u>32</u>	Motion for leave to <i>File Brief in Excess of Page Limitations</i> filed by Touchstone Research Laboratory, Ltd.. Related document(s) <u>14</u> . (Attachments: # <u>1</u> Pleading Reply Brief in Support of Motion to Dismiss and Motion for Summary Judgment# <u>2</u> Exhibit A - Second Declaration of Brian Joseph# <u>3</u> Exhibit B - Declaration of Andrew Pratt# <u>4</u> Exhibit C - Rite Hite Corp. v. Delta T. Corp.# <u>5</u> Exhibit D - Philips v. May# <u>6</u> Exhibit E - Sun Petroleum Products v. Millwrights)(Zych, Thomas) (Entered: 05/31/2007)
05/31/2007	<u>33</u>	Reply in support of <u>16</u> Motion to change/transfer venue <i>DEFENDANT'S MOTION IN THE ALTERNATIVE TO TRANSFER VENUE</i> filed by Touchstone Research Laboratory, Ltd.. (Attachments: # <u>1</u> Exhibit A - Second Declaration of Brian Joseph# <u>2</u> Exhibit B - FTC v. Mazzoni# <u>3</u> Exhibit C - Sun Petroleum Products v. Millwrights)(Zych, Thomas) (Entered: 05/31/2007)
06/08/2007		Order [Non Document]Granting Defendant Touchstone Research Laboratory, Ltd.'s Unopposed Motion for Leave to File Memorandum Exceeding Page Limitation. (Related Doc. #32). Counsel shall file their memorandum upon receipt of this email notification. (Entered on behalf of Judge Lesley Wells on 6/8/2007)(C,LS) (Entered: 06/08/2007)
06/08/2007	<u>34</u>	Reply in support of <u>14</u> Motion to dismiss <i>DEFENDANT'S MOTION (1) TO DISMISS COUNT I (NON-INFRINGEMENT AND INVALIDITY) FOR LACK OF JURISDICTION, AND (2) TO DISMISS AND FOR SUMMARY JUDGMENT ON COUNTS II AND III (EQUITABLE AND LEGAL ESTOPPEL)</i> Motion to dismiss <i>DEFENDANT'S MOTION (1) TO DISMISS COUNT I (NON-INFRINGEMENT AND INVALIDITY) FOR LACK OF JURISDICTION, AND (2) TO DISMISS AND FOR SUMMARY JUDGMENT ON COUNTS II AND III (EQUITABLE AND LEGAL ESTOPPEL)</i> filed by Touchstone Research Laboratory, Ltd.. (Attachments: # <u>1</u> Exhibit Second Declaration of Brian Joseph# <u>2</u> Exhibit Pratt Declaration# <u>3</u> Exhibit Rite-Hite Corp v Delta T Corp# <u>4</u> Exhibit Phillips v May# <u>5</u> Exhibit Sun Petroleum Products v Millwright)(Zych, Thomas) (Entered: 06/08/2007)
06/14/2007	<u>35</u>	Motion for oral argument filed by Touchstone Research Laboratory, Ltd.. (Zych, Thomas) (Entered: 06/14/2007)
06/15/2007	<u>36</u>	Notice of Filing of Original Declaration in Support of Motion to Dismiss and Motion for Summary Judgment filed by Touchstone Research Laboratory, Ltd.. (Attachments: # <u>1</u> Declaration of Andrew Pratt)(Zych, Thomas) (Entered: 06/15/2007)
06/18/2007	<u>37</u>	Response to <u>35</u> Motion for oral argument filed by UCAR Carbon Company,

		Inc.. (Wiedemann, John) (Entered: 06/18/2007)
07/26/2007		Financial Transaction in the amount of \$200.00 received for motion to appear pro hac vice by attorneys Brian C.Riopelle and John A. Leja, Receipt # 14660010395 (C,BA) (Entered: 07/26/2007)
07/26/2007	<u>38</u>	Motion for attorney Brian C. Riopelle to Appear Pro Hac Vice Filing fee 100, receipt number 14660010395. filed by Touchstone Research Laboratory, Ltd.. Filing fee paid; receipt number 14660010395. (Attachments: # <u>1</u> Affidavit of Brian Riopelle)(Zych, Thomas) (Entered: 07/26/2007)
07/26/2007	<u>39</u>	Motion for attorney John A. Leja to Appear Pro Hac Vice Filing fee 100, receipt number 14660010395. filed by Touchstone Research Laboratory, Ltd.. Filing fee paid; receipt number 14660010395. (Attachments: # <u>1</u> Affidavit of John A. Leja)(Zych, Thomas) (Entered: 07/26/2007)
08/08/2007		Order [Non Document]Granting Motion for appearance pro hac vice; Attorney John A. Leja for Touchstone Research Laboratory, Ltd. is added as counsel for Touchstone Research Laboratory, Ltd. (Related Doc # <u>39</u>) (Entered on behalf of Judge Lesley Wells on 8/8/07).(C,LS) (Entered: 08/08/2007)
08/08/2007		Order [Non Document]Granting Motion for appearance pro hac vice. Attorney Brian C. Riopelle is added as counsel for Touchstone Research Laboratory, Ltd. (Related Doc # <u>38</u>)(Entered on behalf of Judge Lesley Wells on 08/08/07)(C,LS) (Entered: 08/08/2007)
09/05/2007	<u>40</u>	<i>Notice of Substitution of Counsel removing Richard S. Meyer and Andrew F. Pratt and adding Brian C. Riopelle and John A. Leja</i> filed by Touchstone Research Laboratory, Ltd.. (Zych, Thomas) (Entered: 09/05/2007)
02/13/2008	<u>41</u>	Opposition to <u>14</u> Motion to dismiss DEFENDANT'S MOTION (1) TO DISMISS COUNT I (NON-INFRINGEMENT AND INVALIDITY) FOR LACK OF JURISDICTION, AND (2) TO DISMISS AND FOR SUMMARY JUDGMENT ON COUNTS II AND III (EQUITABLE AND LEGAL ESTOPPEL) Motion to dismiss DEFENDANT'S MOTION (1) TO DISMISS COUNT I (NON-INFRINGEMENT AND INVALIDITY) FOR LACK OF JURISDICTION, AND (2) TO DISMISS AND FOR SUMMARY JUDGMENT ON COUNTS II AND III (EQUITABLE AND LEGAL ESTOPPEL) filed by UCAR Carbon Company, Inc.. (Attachments: # <u>1</u> Exhibit A - Sony Electronics v. Guardian Media Technologies, 2007 U.S. Dist. LEXIS 82636) (Yanchar, Georgia) (Entered: 02/13/2008)
02/19/2008	<u>42</u>	Motion for leave to <i>File Responsive Brief Instanter or, In the Alternative, to Strike Plaintiff UCAR Carbon Company, Inc.'s Supplemental Brief</i> filed by Defendant Touchstone Research Laboratory, Ltd.. (Attachments: # <u>1</u> Exhibit Exhibit A - Touchstone Response to UCAR Supplemental Brief)(Zych, Thomas) (Entered: 02/19/2008)
02/21/2008		Order [Non Document]Granting Defendant's Motion for leave to file responsive brief instanter. (Related Doc # <u>42</u>) Counsel shall file their brief upon receipt of this notification. (Entered on behalf of Judge Lesley Wells on